

Application No. 09/612,067
Filing Date: 07/07/2000
Attorney Docket No. 73081

Applicant(s): NAUMANN
Examiner: Tri H. PHAN
Group Art Unit: 2616

Remarks

This communication is responsive to the Office Action of **September 6, 2007**. Revival, reexamination and reconsideration of the remaining claims is respectfully requested.

Summary of The Office Action

The appeal of this case was dismissed because the brief was not timely filed and the period for obtaining an extension of time had expired. The amended appeal brief filed 5-25-2007 was held to be defective.

Response

The Claims Patentably Distinguish Over the References of Record

35 U.S.C. §103

To establish a *prima facie* case of 35 U.S.C. §103 obviousness, basic criteria must be met. The prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.(A) Section 2131 of the MPEP recites how "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). This same standard applies to 103 rejections as evidenced by Section 2143(A) of the MPEP, which reads: "The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements** were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions".

Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This requirement is intended to prevent unacceptable "hindsight reconstruction" where Applicant's invention is recreated from references using the Application as a blueprint.

Here, the criteria for establishing a *prima facie* case of obviousness are not satisfied since the combination of references does not teach or suggest all the claim limitations. None of the references, alone and/or in combination, teach disabling a connection on a router's IDSEL pin when an FE PHY (fast Ethernet physical layer

device) is not present on a back card in the router. Thus, none of the claims are obvious for at least this reason.

Independent Claims 1, 10, 18

Claim 1 recites a method for detecting the absence of a PHY layer device on a back card. Independent claims 10 and 18 recite similar elements and limitations in different claim formats (e.g., apparatus, means plus function).

The method is performed in a router having a front card. The front card is a PCI-compliant device that is an FE MAC. The back card to be detected is an FE PHY. The method includes receiving a sensing signal. The sensing signal is received by a switching input of a tri-state buffer on the front card. If the signal is low, then an IDSEL signal is coupled in a first way. If the signal is not low, then the IDSEL signal is decoupled in a second way. The sensing and coupling are clearly illustrated in the application as originally filed.

As stated on pages 13 and 14 of the application as originally filed, “when a FE PHY is present, the switch 116 is opened, the IDSEL connection 106 is coupled to the FE MAC 110, and the back card will be coupled to the front card via the bus per normal PCI procedures.” Page 13, lines 8-10. “When the switch 116 is closed, the IDSEL connection 106 is decoupled from the FE MAC 110.” Page 14, lines 1-2. Thus, particular sensing and switching are claimed and described.

During the long history of this matter, the Office Actions have all ignored this particular sensing and switching and have relied on Bontemps et al., (U.S. 5,923,663) (Bontemps). However, Bontemps has never taught the recited elements. Bontemps teaches a method for detecting whether there is a device connected to a port on a networking device. Bontemps does not teach detecting whether a port is present in a router.

Bontemps does not teach communication between a PCI-compliant front card configured to accept a back card FE PHY and that utilizes IDSEL signaling between

the front card and the back card. Consider that an FE MAC on a PCI-compliant front card is permanently located on the front card. This causes the problem solved by the claimed invention. Bontemps does not disclose the PCI-compliant front card, nor a back card providing an FE PHY and thus cannot possibly teach solving the particular problem created by having the FE MAC on the PCI-compliant card permanently located on the front card.

The Office Actions have relied on element 100 in Figure 1 of Bontemps. However, this figure and element concern a computer network that teaches nothing about the claimed method concerning the front card, back card detection and communication.

For at least these reasons, the claims have never, and remain, not obvious over the combination of references. Therefore Applicant respectfully requests allowance of the remaining claims.

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CONCLUSION

For the reasons set forth above, the claims are now in condition for allowance. An early allowance of the claims is earnestly solicited.

Respectfully submitted,



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